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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/676,367

10/01/2003

Theodore Nathanson

NATHANSON et al.-PA-2

3220

7590

05/24/2005

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BALTIMORE, MD 21202

EXAMINER

HOGE, GARY CHAPMAN

ART UNIT

PAPER NUMBER

3611

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/676,367	NATHANSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gary C Hoge	3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 4-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

EA

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: “2.53” (see Fig. 3).
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the line, dashed line, shaded field and small print recited in claim 3 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Election/Restrictions***

3. Claims 4-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 26, 2005.

Applicant elected Species II, which is the embodiment illustrated in Fig. 3. Although Applicant indicated in the response filed February 26, 2005, that only claim 7 did not read the elected embodiment, a reading of the claims shows that each of claims 4-12 include features that are unique to embodiments other than the one illustrated in Fig. 3. Therefore, these claims do not read on the elected embodiment and have been withdrawn.

***Claim Objections***

4. Claim 1 is objected to because of the following informalities:

On line 11 (Applicant's numbering), it appears that "portions" should be "portion".

On line 14, it appears that "said flap tab portions" should be "said at least one flap tab portion".

On line 15, it appears that "said flap tab portions" should be "said at least one flap tab portion".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, the tab is said to be an “indexed tab portion.” The use of the word “indexed” is not understood in this context. The verb *to index* means “to furnish with an index” or “to indicate or signal.” It is not understood how these ideas would apply to the tab recited in claim 2.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan in view of Mayer and Hillemann et al.

Morgan discloses a method comprising the steps of selecting one or more substantially flexible indicia **14, 16** from an indicia source, each of the indicia having indicia information to be displayed, selecting one or more substantially rigid holders **12** from a holder source, each of the holders having holder information to be displayed; applying one or more of the indicia to each of the holders, to form a combined indicia and holder; selecting a display **20** from a display source for each of the holders selected, wherein the display comprises a pocket portion, inserting the combined indicia and holder into the pocket portion of the display, and displaying the displayed indicia information and displayed holder information. Morgan does not disclose that there is hidden indicia on either the flexible indicia or the rigid holder. However, it is well known to provide instructional indicia that is intended to be hidden during use. Mayer shows an example of such indicia. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include hidden instructional indicia (e.g., "Place stamp here," or "Insert under tab", etc.) to either or both of the indicia and/or the holder, as taught by Mayer, in order to instruct the user in the proper use of the invention. Further, the display disclosed by Morgan does not include a flap tab portion with reusable adhesive attached thereto. Hillemann et al. teaches that it was known to provide a transparent display with a flap having a reusable adhesive in order to protect the contents of the display by releasably sealing them inside the display. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the display disclosed by with a flap having an adhesive portion in order to protect the contents of the display by releasably sealing them inside the display. When the flap is sealed the adhesive portion is concealed. Conversely, when the flap is opened, the adhesive portion is revealed.

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10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan in view of Hillemann et al.

Morgan discloses an indicia 14, 16; a holder unit 12; and a display unit 20 having a pocket portion. However, the display unit does not have a tab portion. Hillemann et al. teaches that it was known to provide a transparent display with a tab having a reusable adhesive in order to protect the contents of the display by releasably sealing them inside the display. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the display disclosed by with a tab having an adhesive portion in order to protect the contents of the display by releasably sealing them inside the display.

Regarding claim 3, the recitation that the indicia has two sets of indicia separated by a line, a dashed line, a shaded field or small print does not patentably define over Morgan because it has been held that patentable novelty cannot be principally predicated on mere printed matter and arrangements thereof, but must reside basically in physical structure. *In re Montgomery*, 102 USPQ 248.

### ***Conclusion***


11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gary C Hoge  
Primary Examiner  
Art Unit 3611

gch